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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,982	05/03/2001	Ted E. Dunning	22227-05479	8782

758 7590 09/24/2002

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EXAMINER

WONG, LESLIE

ART UNIT PAPER NUMBER

2177

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,982

Applicant(s)

DUNNING ET AL.

Examiner

Leslie Wong

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. Applicants are reminded to update the cited co-pending application serial numbers for the incorporated subject matter by reference.

The following is a quote in part of MPEP 608.01(p), concerning the incorporation of subject matter by reference:

"The Commissioner has considerable discretion in determining what may or may not be incorporated by reference in a patent application. *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). The incorporation by reference practice with reference to applications which issue as U.S. patents provides the public with a patent disclosure which minimizes the public's burden to search for and obtain copies of documents incorporated by reference which may not be readily available. Through the Office's incorporation by reference policy the Office ensures that reasonably complete disclosures are published as U.S. patents. The following is the manner in which the Commissioner has elected to exercise that discretion.

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112. Material nevertheless may be incorporated by reference, *Ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966). An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent or (2) a pending U.S. application, subject to the conditions set forth below.

"Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign application.

Nonessential subject matter may be incorporated by reference to (1) patents or applications published by the United States or foreign countries or regional patent offices, (2) prior filed, commonly owned U.S. applications, or (3) non-patent publications. Nonessential subject matter is subject matter referred to for purposes of indicating the background of the invention or illustrating the state of the art.

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144, (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. Guidelines for situations where applicant is permitted to fill in a number for Serial No. _____ left blank in the application as filed can be found in *In re Fouché*, 439

F.2d 1237, 169 USPQ 429 (CCPA 1971) (Abandoned applications less than 20 years old can be incorporated by reference to same extent as copending applications; both types are open to public upon referencing application issuing as a patent)."

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-35 are rejected under 35 U.S.C. 102(b) as being anticipated by **Damashek** (U.S. Patent 5,418,951).

Regarding claims 1, 12, 23, and 34, **Damashek** teaches a computer-implemented method of text equivalencing from a string of characters 3 comprising:

- a). modifying the string of characters using a predetermined set of heuristics (col. 4, line 64 – col. 5, line 5; col. 8, line 64 col. 9, line 2);
- b). comparing the modified string with a known string of characters in order to locate a match (col. 4, lines 56-59);
- c). responsive to not finding a match, forming a plurality of sub-strings of characters from the string of characters (col. 3, lines 21-24; col. 4, lines 24-27); and

d). using an information retrieval technique on the sub-strings of characters to determine a known string of characters equivalent to the string of characters (col. 9, lines 64-66).

Regarding claims 2, 13, 24, and 35, **Damashek** further teaches a step wherein the information retrieval technique further comprises:

- a). weighting the sub-strings (col. 5, lines 31);
- b). scoring the known string of characters (col. 8, lines 51-56); and
- c). retrieving information associated with the known string of characters with the highest score (col. 9, lines 64-66).

Regarding claims 3, 14, and 25, **Damashek** further teaches a step comprising, responsive to the highest score being greater than a first threshold, automatically accepting the known string of characters as an exact match (col. 8, lines 51-63).

Regarding claims 4, 15, and 26, **Damashek** further teaches a step comprising, responsive to the highest score being less than a second threshold and greater than a first threshold, presenting the known string of characters to a user for manual confirmation (col. 9, lines 12-14; col. 10. 45-49).

Regarding claims 5, 16, and 27, **Damashek** further teaches a step comprising, responsive to the highest score being less than a second threshold and greater than a

third threshold, presenting the known string of characters to a user to select the equivalent string of characters (col. 9, lines 12-14; col. 10. 45-49).

Regarding claims 6, 17, and 28, **Damashek** further teaches a step wherein the sub-strings of characters are 3-grams (col. 3, lines 21-24; col. 4, lines 24-27).

Regarding claims 7, 18, and 29, **Damashek** further teaches a step wherein the string of characters is selected from the group consisting of a song title, a song artist, an album name, a book title, an author's name, a book publisher, a genetic sequence, and a computer program (col. 9, lines 35-37).

Regarding claims 8, 19, and 30, **Damashek** further teaches a step wherein the predetermined set of heuristics comprises removing whitespace from the string of characters (col. 4, line 64 – col. 5, line 5).

Regarding claims 9, 20, and 31, **Damashek** further teaches a step wherein the predetermined set of heuristics comprises removing a portion of the string of characters (col. 8, line 64 – col. 9, line 10).

Regarding claims 10, 21, and 32, **Damashek** further teaches a step wherein the predetermined set of heuristics comprises replacing a symbol in the string of characters with an alternate representation for the symbol (col. 4, line 64 – col. 5, line 5).

Regarding claims 11, 22, and 33, **Damashek** further teaches a step wherein storing an indication (i.e., similarity score) that the string of characters is the equivalent of the known string of characters (col. 8, lines 51-56).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sharnoff et al. (U.S. Patent 6,314,421) teaches method and apparatus for indexing documents for message filtering.

Carus et al. (U.S. Patent 6,035,268) teaches method and apparatus for breaking words in a stream of text.

Schmitt (U.S. Patent 5,062,143) teaches trigram-based method of language identification.

Zamora et al. (U.S. Patent 4,833,610) teaches morphological/phonetic method for ranking word similarities.

Rangarajan et al. (U.S. Patent 5,706,365) teaches system and method for portable document indexing using n-gram word decomposition.

Brown et al. (U. S. Patent 6,026,398) teaches system and methods for searching and matching databases.

Martino et al. (U.S. Patent 5,548,507) teaches language identification process using coded language words.

Register et al. (U.S. Patent 5,371,807) teaches method and apparatus for text classification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 305-3018. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Leslie Wong
Patent Examiner
Art Unit 2177

lw
September 19, 2002



JOHN BREENE
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